

and Los Angeles and/or those who are desirous of obtaining such improvement, reduction and/or prevention. Thus, the claimed invention is directed to methods of applying phytanetriol to the keratin materials in need of such protection, improvement, reduction and/or prevention in an amount sufficient to limit the adhesion or adsorption of pollutants on skin, thereby substantially keeping pollutants off the skin and limiting the amount of pollutants penetrating into the skin.

Neither of the cited Ribier references necessarily results in limiting adhesion or adsorption of pollutants to keratin materials in need of the claimed protection, improvement, reduction and/or prevention. Rather, the Ribier references merely result in the possibility that the claimed pollution penetration limitation on keratin materials in need of such protection, improvement, reduction and/or prevention may occur. Because the cited Ribier references merely result in the possibility that the claimed methods may occur, they cannot inherently anticipate the claimed invention. See, In re Robertson, 169 F.3d 743 (Fed. Cir. 1999) (Inherency may not be established by probabilities or possibilities. The mere fact that a thing may result from a given set of circumstances is not sufficient).

Moreover, none of the cited references, alone or in combination, teaches or suggests methods of using a pollution penetration limiting effective amount of phytanetriol on keratin materials in need of the claimed protection, improvement, reduction and/or prevention, or the benefits or mechanisms associated with these methods. Accordingly, the claimed methods represent an advance in the art deserving of patent protection.

In view of this background, each of the rejections made in the outstanding Office Action will now be addressed in turn.

### **REJECTIONS UNDER 35 U.S.C. §§102 and 103**

The Office Action rejected claims 1-24 and 26-31 under 35 U.S.C. §102 as anticipated by U.S. patent 6,071,524<sup>1</sup> ("Ribier I"), and claims 1-3, 5, 6, 15, 17-19, 21, 23, 24, 26-28 and 30-31 under 35 U.S.C. §102 as anticipated by U.S. patent 5,834,018 ("Ribier II").

These § 102 rejections were based upon the belief that the Ribier references inherently disclose the claimed methods. The Office Action also rejected claims 1-4, 23-24, 26, 28, 29 and 31 under 35 U.S.C. §103 as obvious over U.S. patent 6,207,694 ("Murad") in view of JP 61236737 ("Kuraray"), and claims 1-4, 23, 24, 26 and 29 under 35 U.S.C. §103 as obvious over U.S. patent 6,110,450 ("Bergmann") in view of Kuraray. In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of these rejections.

Ribier I does not disclose or suggest, either expressly or inherently, the claimed methods. Ribier I discloses compositions containing phytanetriol but does not provide any instruction regarding how to use or apply such compositions. Thus, Ribier I does not contain any teaching regarding application or use that would result each and every time in limiting the adhesion or adsorption of pollutants to skin, thereby limiting penetration of pollutants into the skin. Moreover, Ribier I does not contain any disclosure that would necessarily result in a person using a pollution penetration limiting effective amount of phytanetriol on keratin materials in need of the claimed protection, improvement, reduction and/or prevention each and every time Ribier I's compositions were used. For example, not every person using Ribier I's compositions would be in need of or desirous of the presently claimed protection,

---

<sup>1</sup> The Office Action refers to U.S. patent 6,207,694 instead of U.S. patent 6,071,524. However, because the '694 patent issued to Murad and not Ribier, presumably this rejection is based on the '524 patent.

improvement, reduction and/or prevention because they do not live in an urban area and/or they do not desire to obtain the claimed benefits. Because not every person using Ribier I's compositions would limit pollution penetration on keratin materials in need of the claimed protection, improvement, reduction and/or prevention, Ribier I cannot and inevitably does not lead to the claimed methods. Accordingly, Ribier I does not inherently anticipate the claimed methods.

Similarly, Ribier II does not contain any teaching that would necessarily result in a person using a pollution penetration limiting effective amount of phytanetriol on keratin materials in need of the claimed protection, improvement, reduction and/or prevention each and every time Ribier II's compositions were used. For example, Ribier II's compositions are used to hydrate skin, (col. 7, lines 15-22) but not every person seeking to hydrate skin would be in need of or desirous of the claimed protection, improvement, reduction and/or prevention. Moreover, as noted above in connection with Ribier I, not every person using Ribier II's composition would be in need of or desirous of the claimed benefits (because they do not live in an urban area and/or do not desire such benefits). Because not every person using Ribier II's compositions would limit pollution penetration on keratin materials in need of the claimed protection, improvement, reduction and/or prevention, Ribier II cannot and does not necessarily lead to the claimed methods. Accordingly, Ribier II does not inherently anticipate the claimed methods.

Regarding the §103 rejections, the Office Action admits that neither Murad nor Bergman teaches using phytanetriol for protective purposes, let alone the claimed protective purposes. Kuraray does not compensate for these deficiencies. Kuraray merely discloses that phytanetriol has "protective action." Kuraray neither teaches, suggests nor recognizes that phytanetriol can limit pollution penetration on keratin materials in need of the claimed

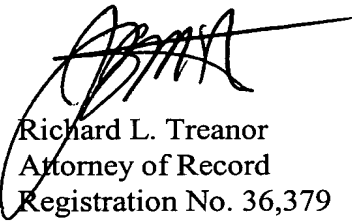
protection, improvement, reduction and/or prevention. Thus, the combination of Bergman or Murad with Kuraray cannot yield the presently claimed invention and, thus, cannot render it obvious.

In view of the above, Applicant respectfully submits that the rejections under 35 U.S.C. §§102 and 103 should be withdrawn.

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Richard L. Treanor  
Attorney of Record  
Registration No. 36,379

Jeffrey B. McIntyre  
Registration No. 36,867



**22850**

Tel #: (703) 413-3000  
Fax #: (703) 413-2220

I:\user\JBMCAL\Orea\208594 amd aft final Conv.doc

**Marked-Up Copy**

Serial No: 09/875,994  
Amendment Filed on:  
September 16, 2002

1. (Twice Amended) A method of protecting keratin materials from the harmful effects of pollution, comprising topically applying a composition comprising a pollutant penetration limiting effective amount of phytanetriol to [said] keratin materials in need of protection from the harmful effects of pollution.

23. (Twice Amended) A treatment process for protecting a keratin material against the effects of pollution, comprising applying to a [the] keratin material in need of protection from the effects of pollution a composition comprising a pollutant penetration limiting effective amount of phytanetriol in a physiologically acceptable medium.

24. (Twice Amended) A treatment process for improving the cell respiration and/or for reducing the desquamation of a keratin material and/or for preventing a keratin material from becoming dull and/or dirty comprising applying to a [the] keratin material in need of said improvement, reduction and/or prevention a composition comprising a pollutant penetration limiting effective amount of phytanetriol in a physiologically acceptable medium.